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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,157	10/29/2003	Peggy K. Dear	21321.00	7145

7590 10/05/2004

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EXAMINER

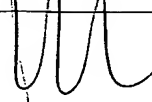
SUHOL, DMITRY

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/695,157	Applicant(s) DEAR, PEGGY K. 	
	Examiner Dmitry Suhol	Art Unit 3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: Claim 1 is missing a period at the end thereof. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 16, the "means for holding paws together" can not be determined. The specification does not seem to provide a means type as claimed by the applicants. The applicants have invokes USC 112 6<sup>th</sup> Paragraph but have not provided clear structure in their specification for the examiner to determined what means the applicants are claiming.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 7, 14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughey et al '863 in view of Lui '551. Hughey discloses a stuffed figure (col. 2, line 55) having a head, torso, ears, large eyes, neck (read onto the region between the head and torso), torso including a chest, limbs with wrists, paws (read onto the ends of respective arm members), large feet (figures 6-10), an activity theme accessory indicative of an activity (figures 1-10, where it is clear that the stuffed animal is associated with various accessories indicative of activities, such as, bowling, basketball, tennis, golf fishing among others). Indicia, as required by claims 1 and 7, is shown as indicia of the front torso region (e.g. chest area as required by claim 7) of the stuffed animal in figures 6-10). An activity being reading a book and a book, as required by claim 14, is disclosed in col. 8, lines 1-2.

Hughey fails to explicitly teach that his stuffed figure is a rabbit in a sitting position, as required by claim 1. However, Liu teaches that it is known to provide a stuffed rabbit in a sitting position with a theme related accessory (figures 1-6). Therefore it would have been obvious to one having ordinary skill in the art, at the time of applicants invention to have manufactured the stuffed figure of Hughey in the form of a sitting rabbit for the purpose of amusement of the user. Furthermore the particular form of the stuffed figure and it's positioning is considered a pure design choice in that applicants disclose no advantage or critical need for such a form and positioning (see applicants specification page 9, lines 7-11).

Regarding claim 16, although Hughey fails to explicitly teach an activity being teaching and a pointing stick, it would have been obvious to incorporate a teaching activity and a pointing stick since Hughey clearly discloses that his invention encompasses professional activities (col. 9, lines 2-4) and teaching is a notoriously well known professional activity which is notoriously known to utilize a pointing stick. Furthermore, the particular theme associated with the stuffed figure is considered a pure design choice in that applicants disclose no advantage or critical need for such a specified theme (see applicants specification page 11, lines 18+).

Claims 2-6 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughey et al '863 and Lui '551, as stated above, and further in view of Perryman '584 and Carraway '363. Hughey, as modified by Lui, discloses all of the elements of the claims as stated above, but for indicia being a poem as required by claim 2. However, Perryman discloses a stuffed toy figure (10) and further teaches that it is known to provide such a figure with poem related to the figure or some aspect of the figure, while Carraway discloses a stuffed figure (10) which also teaches that it is known to provide indicia with a stuffed figure in the form of a poem (col. 3, lines 30-39) which is attached to or on the figure. Therefore it would have been obvious to one having ordinary skill in the art, at the time of the applicants invention to provide indicia in the form of a poem directed to an aspect/activity theme portrayed by the stuffed figure for the purpose of introduction and description to the recipient. Furthermore, it would have been obvious to utilize indicia in poem format since it would only depend on the

intended use of the assembly and the desired information to be displayed. Additionally, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of message does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. a poem) and the substrate (e.g. stuffed figure) which is required for patentability.

An activity being tennis and an accessory including tennis equipment, as required by claim 5, are shown in figure 8.

Regarding claims 3-4 and 6, although Hughey fails to explicitly teach that his figure is drawn to specific sports such as, baseball, football, and majorette, the reference makes it clear that toy figures related to such themes are notoriously well known in the art (col. 1, lines 26-35) as well as stating that the stuffed toy figure encompasses a wide variety of activity themes (cols 7-8, lines 64+ and 1-6, respectively). Therefore it would have been obvious to incorporate the themes of baseball, football and majorette with the device of Hughey for the purpose of added amusement to the user through a variety of motifs. Furthermore, the particular theme associated with the stuffed figure is considered a pure design choice in that applicants

disclose no advantage or critical need for such a specified theme (see applicants specification page 11, lines 18+).

Regarding claims 10-13, Carraway clearly teaches that it is known to provide a pamphlet (30) attached to a stuffed toy (figure 1 and col. 3, lines 24-29). Therefore it would have been obvious to attach indicia in the form of a pamphlet to the toy of Hughey for the purpose of preventing loss. Regarding the specific attachment location it would have been obvious to attach the pamphlet to any location since the examiner takes official notice that such construction is well known in the art. Furthermore the specific attachment location is considered to be a design choice in that applicants do not disclose any advantage of criticality for any one of the locations (see applicants specification pages 9-12).

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughey et al '863 and Lui '551, as stated above, and further in view of Chen '311. Hughey, as modified by Lui, discloses all of the elements of the claims as stated above, but for indicia located on the soles of the stuffed figure. However, Chen discloses a stuffed figure which teaches that it is known to provide a stuffed figure with indicia related to a sports theme located on the chest and soles of the figure (figure 1). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the applicants invention to provide a stuffed figure with indicia on it's soles for the purpose of interest and amusement of the user. Furthermore, it would have been obvious to place indicia on the soles of the stuffed animal since it would only depend on

the intended use of the assembly and the desired information to be displayed. Additionally, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with indicia in a specific location does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. indicia) and the substrate (e.g. soles of the stuffed figure) which is required for patentability.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hughey et al '863 and Lui '551, as stated above, and further in view of Cox '385 or Schiavo et al '751. Hughey, as modified by Lui, discloses all of the elements of the claims as stated above, but for an activity being praying. However, Hughey clearly teaches that a wide variety of activities are encompassed in his invention (cols 7-8, lines 64+ and 1-6, respectively), while both Schiavo and Cox clearly teach that it is known to provide toy figures related to a prayer activity where the hand/paws members are held together. Therefore it would have been obvious to incorporate the activity of prayer in the device of Hughey as modified by Lui for the purpose of added amusement to the user through a variety of motifs. Furthermore, the particular theme associated with the stuffed figure



is considered a pure design choice in that applicants disclose no advantage or critical need for such a specified theme (see applicants specification page 11, lines 18+).

### ***Response to Arguments***

Applicant's arguments filed June 18<sup>th</sup>, 2004 have been fully considered but they are not persuasive. Applicants argue that Hughey fails to disclose indicia as claimed by the applicants in claim 1. In response the examiner points out that the only structural limitation present in applicants claims is "...indicia on said stuffed rabbit..." in which case the indicia disclosed in Hughey clearly reads upon the indicia of the applicants as presented in claim 1.

Applicants further argue that the indicia of Carraway is structurally and functionally different from the indicia as claimed by the applicants since Carraway provides a "blank slate" upon which individuals may inscribe messages. In response the examiner points out that Carraway is relied upon to teach preprinted indicia (not a blank surface as purported by the applicants)) being a poem in a pamphlet form (30 col. 3, lines 30-39) attached to and related to a stuffed doll (figure 1). The fact that a user may or may not write on the surface of the card is irrelevant.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ds

A handwritten signature in black ink, appearing to read 'D. H. Banks', with a long horizontal line extending to the right.

DERRIS H. BANKS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700